

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Chesnut *et al.*

Appl. No.: 10/005,876

Filed: December 7, 2001

For: **Methods and Compositions for
Synthesis of Nucleic Acid
Molecules using Multiple
Recognition Sites**

Confirmation No.: 7958

Art Unit: 1636

Examiner: Ketter, J.S.

Atty. Docket: 0942.5340002/RWE/BJD/JKM

Eighth Supplemental Information Disclosure Statement

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450
Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98.

The numbering on this Eighth Supplemental Information Disclosure Statement is a continuation of the numbering in Applicants' Seventh Supplemental Information Disclosure Statement filed September 24, 2004, in connection with the above-captioned application.

Copies of documents **AF10-AK10**, **AA11-AK11**, and **AA12-AE12** are not provided in accordance with the Changes To Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan, effective October 21, 2004, which states "section 1.98(a)(2)(i) is amended to eliminate the requirement in paragraph (a)(2)(i) for a copy of each U.S. patent or U.S. patent application publication listed in an IDS in a patent application regardless of the filing date of the application."

Copies of documents **AS135**, **AT135** and **AR136** are not provided in accordance with the U.S. Patent and Trademark Office OG notice of October 19, 2004, which states: "the requirement in 37 C.F.R. § 1.98(a)(2)(iii) for a legible copy of the specification, including the claims, and drawings

of each cited pending U.S. patent application (or portion of the application which caused it to be listed) is *sua sponte* waived where the cited pending application is stored in the USPTO's IFW system." A copy of each other document is provided.

In accordance with 37 C.F.R. § 1.98(a)(3), Applicants' undersigned representative submits the following, in regard to non-English language documents **AP10** and **AL11** cited on Form PTO 1449:

Document **AP10**, French Patent Publication No. FR 2 670 502, is in the French language. Document **AL11**, PCT Patent Publication No. WO 92/10577, is in the French language. An unverified English language abstract of documents **AP10** and **AL11** is attached as document **AR135**.

The Examiner's attention is directed to the following co-pending U.S. Patent Applications, which are directed to related technical subject matter:

U.S. Patent Application No. 10/877,952, Welch *et al.*, filed July 28, 2004 and cited as document **AS135**;

U.S. Patent Application No. 10/991,803, Carrino *et al.*, filed November 17, 2004 and cited as document **AT135**; and

U.S. Patent Application No. 11/000,371, Chesnut *et al.*, filed December 1, 2004 and cited as document **AR136**.

The identification of these U.S. Patent Applications is not to be construed as a waiver of secrecy as to these applications now or upon issuance of the present application as a patent. The Examiner is respectfully requested to consider the cited applications and the art cited therein during examination.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed

publication dates on the attached Form PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

This Information Disclosure Statement is being filed before the mailing of a first Office Action after the filing of a Request for Continued Examination under 37 C.F.R. § 1.114. No statement or fee is required.

It is respectfully requested that the Examiner initial and return a copy of the enclosed Form PTO-1449, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

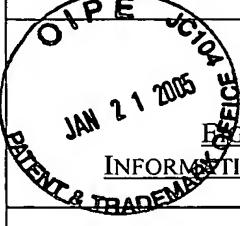
Respectfully submitted,

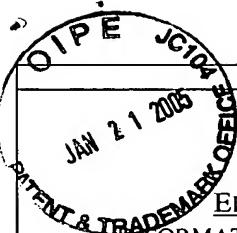
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Brian J. Del Buono
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344639_1.DOC

 FORM PTO-1449 EIGHTH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT					ATTY. DOCKET NO. 0942.5340002/RWE/BJD/JKM	APPLICATION NO. 10/005,876		
					APPLICANT(S) Chesnut <i>et al.</i>			
					FILING DATE December 7, 2001	ART UNIT 1636		
U.S. PATENT DOCUMENTS								
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE	
	AA							
	AB							
	AC							
	AD							
	AE							
	AF10	5,451,513	09/19/1995	Maliga <i>et al.</i>			08/25/1993	
	AG10	5,965,408	10/12/1999	Short			07/09/1996	
	AH10	6,171,820	06/09/2001	Short			02/04/1999	
	AI10	6,238,884	05/29/2001	Short <i>et al.</i>			03/09/1999	
	AJ10	6,352,842	03/05/2002	Short <i>et al.</i>			03/26/1999	
	AK10	6,358,709	03/19/2002	Short <i>et al.</i>			03/09/2000	
FOREIGN PATENT DOCUMENTS								
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION	
	AL						Yes No	
	AM						Yes No	
	AN						Yes No	
	AO						Yes No	
	AP10	FR 2 670 502	06/16/1992	France			X Yes No	
OTHER (Including Author, Title, Date, Pertinent Pages, etc.)								
	AR	<u>132</u>	Office Action for U.S. Patent Application No. 09/907,719, mailed on July 13, 2004					
	AS	<u>132</u>	Office Action for U.S. Patent Application No. 09/432,085, mailed on July 16, 2004					
	AT	<u>132</u>	Office Action for U.S. Patent Application No. 10/058,291, mailed on September 22, 2004					
EXAMINER					DATE CONSIDERED			
EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.								



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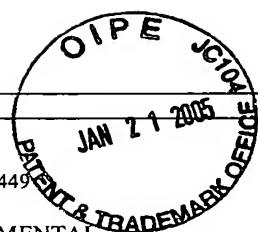
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA11	6,361,974	03/26/2002	Short <i>et al.</i>			03/27/2000
	AB11	6,455,254	09/24/2002	Short			05/15/2000
	AC11	6,479,258	11/12/2002	Short			01/31/2000
	AD11	6,489,145	12/03/2000	Short			10/31/1997
	AE11	6,537,776	03/25/2003	Short			06/14/1999
	AF11	6,605,449	08/12/2003	Short			06/14/2000
	AG11	6,632,600	10/14/2003	Short			11/15/2000
	AH11	2004/0040053	02/26/2004	Nomura <i>et al.</i>			11/22/2002
	AI11	6,709,841	03/23/2004	Short			03/01/2002
	AJ11	6,713,279	03/30/2004	Short			02/04/2000
	AK11	6,713,282	03/30/2004	Short <i>et al.</i>			03/14/2002

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL11	WO 92/10577	06/25/1992	WIPO			Yes X No
	AM11	WO 94/20604	09/15/1994	WIPO			Yes No
	AN11	WO 96/19497	06/27/1996	WIPO			Yes No
	AO11	WO 00/29000	05/25/2000	WIPO			Yes No
	AP11	WO 00/52027	09/08/2000	WIPO			Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

AR	133	Office Action for U.S. Patent Application No. 10/058,292, mailed on September 22, 2004
AS	133	Office Action for U.S. Patent Application No. 09/855,797, mailed on October 1, 2004
AT	133	Office Action for U.S. Patent Application No. 09/695,065, mailed on October 27, 2004
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EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA12	6,740,506	05/25/2004	Short <i>et al.</i>			06/19/2001
	AB12	6,773,900	08/10/2004	Short <i>et al.</i>			03/05/2003
	AC12	2004/0171156	09/02/2004	Hartley <i>et al.</i>			04/02/2004
	AD12	2004/0171157	09/02/2004	Hartley <i>et al.</i>			04/08/2004
	AE12	2004/0219516	11/04/2004	Bennett <i>et al.</i>			07/18/2003
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL12	WO 00/52141	09/08/2000	WIPO			Yes No
	AM12	WO 01/25466	04/12/2001	WIPO			Yes No
	AN12	WO 01/42509	06/14/2001	WIPO			Yes No
	AO12	WO 02/46372	06/13/2002	WIPO			Yes No
	AP12	WO 02/61034	08/08/2002	WIPO			Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	134	Office Action for U.S. Patent Application No. 10/820,133 mailed on November 17, 2004
	AS	134	Office Action for U.S. Patent Application No. 09/907,719 mailed on December 28, 2004
	AT	134	Office Action for U.S. Patent Application No. 09/432,085, mailed on December 28, 2004

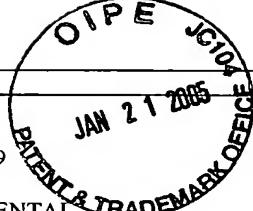
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	AL13	WO 02/62957	08/15/2002	WIPO			Yes No
	AM13	WO 02/86144	10/31/2002	WIPO			Yes No
	AN13	WO 02/095055	11/28/2002	WIPO			Yes No
	AO13	WO 03/044207	05/30/2003	WIPO			Yes No
	AP13	WO 03/103600	12/18/2003	WIPO			Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

AR	<u>135</u>	Dialog File 351, Derwent World Patent Index, English Language Abstract for French Patent No. FR 2 670 502 (Document AP10) and PCT Patent No. WO 92/10577 (Document AL11), WPI Accession No. 9107201
AS	<u>135</u>	U.S. Patent Application No. 10/877,952, Welch <i>et al.</i> , filed July 28, 2004 (NOT PUBLISHED)
AT	<u>135</u>	U.S. Patent Application No. 10/991,803, Carrino <i>et al.</i> , filed November 17, 2004 (NOT PUBLISHED)

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FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL14	WO 04/009768	01/29/2004	WIPO			Yes No
	AM14	WO 04/013290	02/12/2004	WIPO			Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

AR	<u>136</u>	U.S. Patent Application No. 11/000,371, Chesnut <i>et al.</i> , December 1, 2004 (NOT PUBLISHED)				
AS						
AT						

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